

REMARKS

Reconsideration and allowance of the instant application are respectfully requested. Claims 6, 19 and 32 are objected to for being dependent on a rejected base claim. Claims 1-5, 7-18, 20-31, 33 and 34 are rejected. Claims 1-34 remain pending after entry of the present response. No new matter has been added.

Drawings

The Office Action states that the drawings are not in compliance with 37 C.F.R. §1.121(d) because they are hand-drawn and not understandable. However, Applicants submitted formal drawings in compliance with §1.121(d) on December 2, 2002. Another copy of the drawings is attached for the examiner's convenience, and Applicants respectfully request the examiner withdraw his objection to the drawings.

Allowable Subject Matter

Applicants thank the Examiner for indicating allowable subject matter with respect to claims 6, 19 and 32.

Claim Rejections

Claims 1-4, 9-11, 29 and 34 stand rejected as being anticipated by Willars *et al.* (U.S. Pat. Pub. No. US2003/0013443) (hereinafter "Willars"). This rejection is respectfully traversed for the following reasons.

Claim 1 recites, *inter alia*, "a method of handing off a mobile terminal from a first network served by a first access device to a second network served by a second access device..." Willars fails to teach or even suggest a first network served by a first access device and a second network served by a second access device. The Office Action states that a Serving Network reads on a first network and that a Drift Network reads on a second network. Office Action, p. 2-3. Contrary to this assertion, Willars makes no mention of a Serving Network or a Drift Network, but rather discusses a Drift *Controller* and a Serving *Controller*. In fact, Willars teaches a single radio access network 14 having one or more radio network controllers (SRNC &

DRNC). P. 4, ¶ 48; *see also* FIG. 1A. The multiple network controllers may help control radio resources and radio connectivity (p. 1, ¶ 6), but do not suggest or imply the existence of other networks, as asserted by the Office Action on pp. 2-3. That is, Willars only uses a single network. As such, Willars fails to teach or suggest a method of handing off a mobile terminal from a first network served by a first access device to a second network served by a second access device. Claim 1 is thus allowable for at least this reason.

Claims 2-4 and 9-11 are dependent on claim 1 and are thus allowable for at least the same reasons as claim 1 and further in view of the novel and non-obvious features recited therein.

Additionally, claim 3 recites, *inter alia*, “the method of claim 1, wherein steps (1) through (4) are performed without allocating any radio frequency resources of the second access device to communicate with the mobile terminal until after it is determined that the mobile terminal is authorized to be handed off to the second access device.” Even assuming, without admitting, the DRNC is a second access device, Willars does not teach or even suggest that steps (1) through (4) of claim 1 are performed without allocating any radio frequency resources of the second access device to communicate with the mobile terminal until after it is determined that the mobile terminal is authorized to be handed off. To the contrary, Willars states that “if an RNC is a drift RNC (DRNC), it supports the serving RNC (SRNC) by *supplying radio resources* (within the cells controlled by the drift RNC (DRNC)) needed for a connection with the user equipment unit (UE).” P. 2, ¶ 13. Nowhere does Willars suggest that radio resources are not allocated until after authorization. Indeed, Willars actually teaches away from performing the steps (1) through (4) *without allocating* any radio frequency resources of the second access device to communicate with the mobile terminal *until after* it is determined that the mobile terminal is authorized to be handed off to the second access device. Thus, claim 3 is allowable for this additional reason.

Claim 29 recites, *inter alia*, “A method of handing off a mobile terminal from a first network served by a first access device to a second network served by a second access device...” Willars fails to teach or even suggest such a feature. As discussed with respect to claim 1, Willars lacks any teaching of a first and a second network. Willars is directed toward a single

radio network with one or more radio network controllers (RNC). P. 3, ¶ 29. Claim 29 is thus allowable for at least this reason.

Claim 34 depends on claim 29 and is thus allowable for at least the same reasons as claim 29 and further in view of the novel and non-obvious features recited therein.

In addition, claim 34 recites, inter alia, “wherein steps (1) to (4) are performed without allocating any radio frequency resources for communicating between the second access device and the mobile terminal until after it has been determined that the mobile terminal is authorized to be handed off to the second access device.” Similar to the arguments presented with respect to claim 3, Willars fails to teach or even suggest such a feature. As such, claim 34 is allowable for this additional reason.

Claims 5 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Willars in view of Chambert (U.S. Patent No. 5,499,387). This rejection is respectfully traversed for the following reasons.

Chambert generally relates to handoffs in a mobile radio communication system. More specifically, Chambert discloses a method for facilitating a second handoff immediately after a first handoff without requiring that a certain amount of time has elapsed. Col. 1, ll. 48-53. The method involves measuring signal strength from potential surrounding base stations when performing a first handoff and using that same data for making an immediate second handoff. Col. 3, ll. 41-53.

In order to rely on a reference under 35 U.S.C. § 103, the reference must be analogous prior art. MPEP §2141.01(a). Chambert fails to satisfy this requirement and thus, the Examiner’s use of Chambert as a basis for rejection is improper. According to the Federal Circuit, the applied reference “must either be in the field of Applicants’ endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). As discussed above, Chambert deals exclusively with measuring signal strength and using prior measurement data to increase the efficiency of handing off a mobile terminal on two consecutive occasions (one immediately after another), without a significant lapse of time. Applicants’ invention, on the other hand, teaches method and apparatus for *pre-authorizing handovers* of mobile terminals among access routers

in communication networks. Nowhere does Chambert mention or even suggest pre-authorization technology for handovers of mobile terminals. As such, the fields of endeavor of Applicants' invention and the Chambert invention are entirely different. Similarly, Chambert's method of improving consecutive handoff efficiency is not reasonably pertinent to the Applicants' problem of pre-authorizing handovers of a mobile terminal between two networks. Chambert would not have logically "commended itself to [the] inventor's attention in considering his problem." *In re Clay*, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). As such, Applicants respectfully requests the withdrawal of Chambert as a basis of rejection for at least this reason. In addition, even if combined, Chambert does not cure the deficiencies of Willars. Claims 5 and 31 are thus allowable for at least these reasons.

Claims 7, 8, 30 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Willars in view of Kennedy, III *et al.* (U.S. Patent No. 5,966,658) (hereinafter "Kennedy"). This rejection is respectfully traversed for the following reasons.

Kennedy generally relates to the automatic selection of a communication path. More specifically, a mobile unit may automatically select a communication path by considering a variety of factors. Col. 5, ll. 52-66. In short, the mobile unit determines the desirability of each alternate communication path and may switch to an alternate path if the path is deemed more desirable.

Like Chambert, Kennedy fails to satisfy the analogous art requirement. As described above, Kennedy's field of endeavor relates to choosing a communication path that will maximize a particular set of path characteristics. Col. 1, ll. 5-7; *see also* Col. 1, ll. 47-57. In contrast, Applicants' invention teaches a method of performing the handoff of a mobile terminal to a target access device/network using pre-authorization to avoid handovers resulting in a denial of service. Specification, p. 3-4, ¶¶ 11-12. As such, Kennedy's invention does not fall within Applicants' field of endeavor and is highly distinguishable. Moreover, Kennedy is not reasonably pertinent to the problems Applicants' invention seeks to solve and thus, Applicants would not be reasonably expected to examine Kennedy in considering those problems. At no point does Kennedy address or suggest any of the deficiencies of unauthorized handovers identified in Applicants' specification. As such, Applicants respectfully request the withdrawal

of Kennedy as a basis of rejection. In addition, even if combined, Kennedy does not cure the deficiencies of Willars. Claims 7, 8, 30 and 33 are thus allowable for at least these reasons.

Claims 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Willars in view of Igarashi *et al.* (U.S. Patent Pub. No. 2001/0053694) (hereinafter “Igarashi”). This rejection is respectfully traversed for the following reason.

The Office Action fails to offer any evidence why one of ordinary skill in the art would be motivated to combine the Willars and Igarashi references. The Federal Circuit has repeatedly stated that the limitations of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* (emphasis added). The Office Action only offers that the combination would have been obvious “in order to comply with Internet standards of transporting information via IP.” Yet Willars specifically reads on a radio network system that operates of radio communication protocols such as Wideband, Code Division Multiple Access (WCDMA). P. 5, ¶ 51. The Office Action fails to identify and explain the alleged motivation of complying with Internet standards of transporting information via IP (i.e. DIAMETER) in a radio access network. The Office Action is improperly and impermissibly using Applicants’ invention as a blueprint. As such, claims 12 and 13 are allowable for at least this reason.

Claims 14-17 and 22-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Willars in view of Funato *et al.* (U.S. Patent Pub. No. 2003/0087646) (hereinafter “Funato”).

Claim 18 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Willars and Funato in view of Chambert.

Claims 20 and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Willars and Funato in view of Kennedy.

Claims 27 and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of Willars and Funato in view of Igarashi.

The rejections in view of Funato are respectfully traversed for the following reasons.

Based on the 37 C.F.R. §1.131 Declaration of the inventors, Senthil Sengodan, Govind Krishnamurthi and Ram Gopal, submitted concurrently herewith, Applicants antedate Funato by establishing a date of invention prior to the filing date of Funato. The rejections based on Funato are mooted by the filing of the attached declaration; however, should the declaration fail to satisfy the requirements to antedate Funato, Applicants reserve the right to provide more evidence of invention and/or traverse Funato on the merits. Accordingly, Applicants submit that Funato does not constitute prior art to the rejected claims. Without Funato, the Office Action fails to establish a *prima facie* case of obviousness with respect to claims 14-18 and 20-28. Therefore, Applicants respectfully request withdrawal of the rejections of these claims.

CONCLUSION


All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully requests prompt notification of the same. If there are any questions, the examiner is invited to contact Applicants' undersigned representative at the number noted below.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Date: Nov. 19, 2004

By:


Ross A. Dannenberg
Registration No. 49,024
1001 G Street, N.W.
Washington, D.C. 20001-4597
Tel: (202) 824-3153
Fax: (202) 824-3753